

REMARKS/ARGUMENTS

Claims 1 – 5, 10 – 16, and 18 – 19 are presented for consideration. Claims 6 – 9 and 17 have been canceled. Additionally, replacement drawing sheets for Figures 5, 7 and 8 are presented for consideration.

The Examiner has objected to the drawings as not including reference numbers in relation to particular figures. The drawings have been amended to label the string length in Figure 5, to show the string line 32 and label the separation distance 46 and bridge 48 in Figure 7, and to label the spring separation distance in Figure 8. These amended drawings are presented for consideration. The Examiner further objected to the drawings as the hammer is not shown in Figure 5 and the strings are not shown in Figure 6. The specification has been amended to respond to the Examiner's objection and clarify that these items are not visible in these particular Figures. The drawings and specification as amended is presented for consideration, and Applicant respectfully requests withdrawal of the objections to the drawings.

The Examiner rejected Claims 1 -6, 11 – 17 and 19 under 35 U.S.C. §102(e) as being anticipated by Cunningham. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Cunningham teaches a musical instrument having strings and a keyboard overlay so that hammers connected to the keys of the keyboard make contact with the strings. Cunningham does not teach or suggest the direct manipulation or play of the strings. Thus, Cunningham only teaches a conventional piano construction. Conventional pianos do not have hammers with the capability to change the string length. The present invention allows for contacting the strings like a guitar player's fingers to hold the string with a new length. This allows for two notes from

one string due to the changed length. The prior art shows only one note from each string. Thus, the prior art does not show the advantages of the present invention. As currently amended, claim 1 improves upon the teachings of Cunningham by providing a musical instrument having strings, a keyboard overlay with hammers that can work with both the entire string length and create a reduced string length, integrated dampeners, and sufficient space between the overlay edge and the string edge to allow the direct manipulation or play of the strings by the user. This improvement allows both keyboardists and guitarists to play this instrument without learning a different manner of playing. Further, the present invention allows for a variety of tones and sounds during use through the differing methods of use. As Cunningham does not teach an instrument with two methods for playing, Cunningham does not teach the variety of tones and sounds which can be elicited from Applicant's invention. Thus, Cunningham does not show, claim, or teach the limitation of the strings extending past the keyboard overlay a sufficient distance to allow direct playing of the strings as required by Claim 1 and Claim 12. Claims 2 – 5 and 10 – 11 are dependent from Claim 1 so that they also include this limitation that makes them distinguishable over Cunningham. Claims 13 – 16 and 18 – 19 are dependent from Claim 12 so that they also include this limitation that makes them distinguishable over Cunningham. For a 35 U.S.C. 102 rejection, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, because Cunningham does not teach or disclose every aspect of the claimed invention either implicitly or explicitly, the Claims 1 – 5, 10 – 16, and 18 – 19 of the present invention are patentably distinguishable over Cunningham. Thus, Applicant respectfully requests that the rejection of Claims 1 – 5, 10 – 16, and 18 – 19 under 35 U.S.C. §102(e) be withdrawn.

The Examiner further rejected Claims 7 – 9 under 35 U.S.C. 103(a) as being unpatentable over Cunningham in view of Evangelista. Claims 7 – 9 have been cancelled, but a similar limitation has been added to the remaining claims. Evangelista teaches a stringless guitar having blade type members which are actuated by movement of fingers or picks. Evangelista does not teach the use of a keyboard nor the use of strings. The addition of a blade type members to Cunningham's teachings would not teach the stringed keyed instrument allowing direct manipulation of strings as disclosed by Applicant.

Further, it is improper to combine references without a teaching, motivation, or suggestion found in the prior art for combining the references. As noted by the substantial authority covered in MPEP § 2145, § 2143.01, and the decisions of the Federal Circuit, it is improper to use the present application as a means for suggestion for combining the prior art references. No cited references showing a motivation for a 'skill in the art' combination or any reference with a 'means of suggestion' has been cited for combining any of these patents. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01 (*citing In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the prior art references, nor does the Examiner make specific findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or other findings to support a proper obviousness analysis. See *In Re Dembiczak*, 50 U.S.P.Q. 1614, 1618 (Fed. Cir. 1999). Because it is improper to use the present application as a means for suggestion for

combining the prior art, Applicant respectfully requests reconsideration of the obviousness rejection.

Additionally, the combination of the stringless keyboardless instrument of Evangelista with the keyed instrument of Cunningham would destroy the intention of the invention of Cunningham for a keyboard instrument. A combination of references is improper when the combination destroys the intended purpose of the reference. See In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Therefore, Applicant respectfully requests reconsideration and withdrawal of the §103(a) rejection.

The Examiner further rejected Claims 10 and 18 under 35 U.S.C. 103(a) as being unpatentable over Cunningham in view of Murakami. Murakami teaches a keyboard instrument electrically connected to an amplifier. Murakami does not teach the use of a stringed keyed instrument which allows for the direct manipulation of the strings. The addition of an amplifier to Cunningham's teachings would not teach the stringed keyed instrument allowing direct manipulation of strings as disclosed by Applicant. The Examiner has not met the prima facie burden of establishing the incentive for combining or altering Cunningham in the manner hypothesized. Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the prior art references, nor does the Examiner make specific findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or other findings to support a proper obviousness analysis. See In Re Dembiczak, 50 U.S.P.Q. 1614, 1618 (Fed. Cir. 1999). Because it is improper to use the present application as a means for suggestion for combining the prior art, Applicant respectfully requests reconsideration and withdrawal of the §103(a) rejection for Claims 10 and 18.

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Applicant respectfully believes that this is a complete response to the Office Action and earnestly solicits a telephone conference to expeditiously resolve any withstanding issues. Applicant respectfully believes that the amendments have addressed the Examiner's issues and believes the newly amended claims are ready for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Pursuant to 37 C.F.R. §1.136(a), Applicant herewith petitions the Commissioner to extend the time for responding to the August 22, 2005, Office Action for 2 months from November 22, 2005, to January 22, 2006. Applicant encloses herewith a check in the amount of \$225.00 made payable to the Commissioner of Patents and Trademarks for the petition fee.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'David B. Pieper', with a long horizontal line extending to the right.

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Amendment to the Drawings:

Applicant respectfully submits replacement sheets of drawings for Figure 5 and Figures 7 – 8. Figure 5 has been modified to label the string length 44 as described in the specification. Figure 7 has been modified to show the string line 32 and label the separation distance 46 and bridge 48. Figure 8 has been modified to label the spring separation distance.